

REMARKS

Applicants hereby add new claims 23-31. Accordingly, claims 1-31 are pending in the present application.

Claims 1-8 stand rejected under 35 USC §101. Claims 1, 4-7, 9, 12, 15-17, 20 and 22 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,295,423 to Haines et al. Claims 2-3, 8, 10-11, 13-14, 18-19 and 21 stand rejected under 35 USC 103(a) for obviousness over Haines in view of U.S. Patent No. 6,798,997 to Hayward et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the objection to the drawings, Applicants submit revised drawings herewith and Applicants respectfully request withdrawal of the objection to the drawings.

Referring to the objection to the title, Applicants submit a revised title herewith which corresponds to the preambles of the pending claims and accordingly the revised title is highly and clearly indicative of the invention to which the claims are directed. Applicants respectfully request withdrawal of the objection to the title.

Applicants have amended claims 17-22 as indicated herein.

Referring to the 101 rejections, Applicant understands the 101 technical arts class of rejections has been withdrawn by the Board of Appeals in *Ex Parte Carl A. Lundgren*, Appeal No. 2003-2088, regarding Application 08/093,516. A copy of the precedential opinion may be found at <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>. Applicant submits the 101 rejection is improper in view of this decision as well as the following authority.

To the contrary of the unsupported allegations of the Office, Applicant respectfully submits the Office is in error with respect to the 101 rejections and the precedent set by the Court of Appeals for the Federal Circuit makes clear the subject claims recite statutory subject matter.

Initially, Applicant refers the Office to the holdings of *In re State Street*, 47 USPQ2d 159 (Fed. Cir. 1998) and *In re AT&T*, 50 USPQ2d 1447 (Fed. Cir. 1999). Further, 35 USC 101 states any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, is patentable. As recognized by the *State Street* court, the repetitive use of the term "any" in section

101 shows *Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101*. The court further stated that it is improper to read limitations into section 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. *See State Street*, 47 USPQ2d at 1600.

The Federal Circuit has stated in the above-recited opinions that claims directed toward a *useful, concrete or tangible thing or result* recite statutory subject matter. *In re Alappat*, 33 F.3d at 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) requires examination of the claims to determine whether the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a law of nature or an abstract idea (non-statutory), or if the mathematical concept has been reduced to some *practical application rendering it useful (statutory)*. *In re Alappat*, 31 USPQ2d at 1544. Claim 1 clearly recites a useful, practical application by the claimed defining, monitoring and replacing.

Accordingly, Applicant's claims are clearly not merely reciting an abstract idea but rather *recite practical applications which are useful, concrete and tangible results (i.e., the defining, monitoring and replacing of the printer component) which are held to recite statutory subject matter*. Applicant submits that *abstract ideas* are defined in *AT&T* as *mathematical subject matter which stands alone and which has not been reduced to some type of practical application*. *AT&T*, 50 USPQ2d at 1451. Applicant submits that in view of the above, the subject matter of the present application is not mathematical subject matter which stands alone but rather has clearly been reduced to practical applications which are useful.

Applicant respectfully requests that the Office clarify any continuing 101 rejections in a *non-final Action* so Applicant may appropriately respond. In particular, the Office has made bald allegations which are not supported by any authority. There is no evidence that the claims merely recite abstract ideas. In view of the *AT&T* authority, it is clear the claims recite more than abstract ideas and recite patentable subject matter inasmuch as the claims recite practical applications of the claimed defining, monitoring and replacing and as such are not mathematical subject matter which stands alone.

Referring to page 3 of the Action, the Office admits the claims recite a useful,

concrete and tangible result. Applicant submits the claims recite statutory subject matter in view of the above-authority and the authority withdrawing the technical arts rejections. The undersigned is available via telephone at 509-624-4276 to discuss the 101 rejections if desired by the Office.

Referring to the *anticipation* rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As described below, positively-recited limitations of each of the claims is not taught by Haines and any continued *anticipation* rejections of the claims over Haines are improper for at least this reason.

Referring to claim 1, the method recites replacing a printer component when a printer component event is detected in a printer. This limitation is not disclosed by Haines and accordingly the anticipation rejection of claim 1 is improper.

More specifically, referring to page 6 of the Office Action, it is alleged that the teachings of col. 1, lines 28-29 and col. 9, lines 1-2 of Haines disclose the positively-claimed replacing. Applicants respectfully disagree. In particular, the teachings of col. 2 relied upon by the Office merely disclose that components may be replaced when the lifetimes of the components have expired. Further, the teachings in col. 9 merely state that replacement of consumable items is facilitated without providing any teachings of details regarding replacement. The teachings of Haines relied upon by the Office do not disclose the specifically claimed replacing the printer component when a printer component event is detected in a printer. To the contrary, Haines is replete with teachings that the only action provided responsive to the monitoring is generation of a notification. There is no teaching of the specifically claimed replacing or that the replacing occurs when the printer component event is detected in the printer. The anticipation rejection is improper for at least this reason.

In addition, Haines discloses generation of a notification when a default or user defined threshold is detected at col. 2, line 40. The thresholds of Table 1 relied upon by the Office merely refer to generating the notifications when the consumable reaches the selected threshold value. There is no teaching of the how replacement is to be

implemented or that replacing occurs when a printer component event is detected in a printer as claimed. To the contrary, the teachings of Haines in col. 6 make clear the notifications are provided prior to expiration of the consumable according to the threshold. There are no teachings that replacement of the consumable occurs when the threshold is detected prior to the expiration of the consumable. Indeed, such an interpretation would result in waste of consumable resources with no apparent benefit or explanation provided. Haines merely discloses that notification is provided when a consumable reaches a respective threshold which fails to disclose any replacement of the printer component when a printer component event is detected in the printer.

Positively-recited limitations of claim 1 are not disclosed by the teachings of Haines. In accordance with the above-recited authority, Applicants respectfully submit that the anticipation rejection is in error and claim 1 recites allowable subject matter.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 9, the system stands rejected for alleged *anticipation* over the teachings of Haines. Applicants respectfully disagree with the anticipation rejection and submit that claim 9 positively recites limitations which are not disclosed nor suggested by Haines.

In particular, claim 9 specifically claims a *rules-based printer component management system configured to monitor printers in the first and second organization*. The Office has failed to identify any teachings of the prior art which allegedly disclose the claimed rules-based printer component management system. Further, Haines discloses monitoring using a lifetime monitoring mechanism having reference 30a of Fig. 3. However, as set forth in col. 3, lines 7-9 of Haines, it is clear that the mechanism 30a is a peripheral unit system of the printer and there is absolutely no teaching or suggestion of the lifetime monitoring mechanism of Haines *monitoring a plurality of printers let alone the plurality of printers in the first and second organizations* as positively claimed. Accordingly, at least the limitations of the claimed rules-based printer component management system are not disclosed nor suggested by Haines and the anticipation rejection is improper for at least this reason and in view of the above-recited authority.

If the anticipation rejection of claim 9 is not withdrawn in the next Action, Applicants respectfully request correction of the deficiencies of the present Action in a *non-final Action* so Applicants may appropriately respond during the prosecution of the present application. In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if the claims are not found to be allowable.

Further, Haines fails to disclose or suggest *replacing the printer component in which the printer component event occurred* as specifically defined in claim 9. The anticipation rejection is in error for this additional reason.

The claims which depend from independent claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 15, the system recites the rules-based printer component management system monitors the printers by receiving a notification from the printer that a printer component event has occurred. The Office relies upon the teachings of col. 2, col. 6 and Fig. 3 of Haines in support of the rejection. However, Applicants respectfully submit the teachings relied upon by the Office refer to *structure and operations internal of a printer and generation of a notification* and fail to disclose or suggest the management system monitoring printers by *receiving notification from the printer that an event has occurred* as claimed.

More specifically, col. 2 discloses that a notification is generated which is void of any reception teachings in a management system. The teachings in col. 6 pertain to the warning generator 35 for generating a warning and such teachings are void of any reception of the notification as explicitly claimed. In addition, the warning generator 35 of Fig. 3 is internal to the printer as set forth in col. 3, lines 7 + of Haines and fails to disclose or suggest any reception of a notification from a printer as explicitly claimed.

Positively-recited limitations of claim 15 are not disclosed nor suggested by the prior art and the anticipation rejection is in error for at least this reason.

Referring to independent claim 17, the monitoring comprises monitoring *printer component conditions of more than organization using a computer executing the computer-executable instructions*. Initially, the teachings of Haines relied upon by the Office refer to monitoring a printer using a lifetime monitoring mechanism internal of the same printer being monitored. Accordingly, the monitoring of Haines fails to disclose or suggest the monitoring using the claimed computer. Furthermore, *the monitoring of the printer using the printer of Haines* fails to disclose or suggest the computer of claim 17 *monitoring of the printer component conditions of more than one organization*. Although, the printer 10 of Fig. 1 of Haines is coupled with a network, Applicants have been unable to locate any teachings plural printers being provided in the computer network or that the lifetime monitoring mechanism of printer 10 monitors any other printer 10. Positively-recited limitations of claim 17 are not disclosed nor suggested by the prior art and the Office has failed to establish a proper anticipation rejection for at least this reason. Applicants respectfully request withdrawal of the anticipation rejection and allowance of claim 17 in the next Action.

The claims which depend from independent claim 17 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 22, Haines discloses generating a notification but Applicants have failed to uncover teachings regarding reception of the notification. The Office relies upon teachings in col. 2, col. 6 and Fig. 3. However, the teachings in col. 2, lines 38-40 merely generically disclose that a notification is generated without any reference to reception thereof. The teachings in col. 6 merely refer to generation of warning without reference to reception thereof. Furthermore, element 35 of Fig. 3 is the warning generator without reference to reception of the warning or other notification. The teachings relied upon by the Office fail to disclose or suggest reception of a notification let alone *receiving notification from an organization when a printer component event has occurred in a printer in the organization* as explicitly claimed. Applicants respectfully request withdrawal of the anticipation rejection and allowance of claim 17 in the next Action.

Applicants hereby add new claims 23-31 which are supported at least by the embodiments of Figs. 1-3 and the associated specification teachings of the originally-filed application.

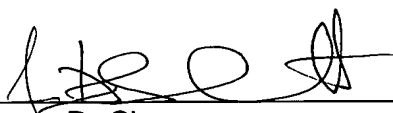
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Richard S. Seymour

By:


James D. Shaurette
Reg. No. 39,833/
Date: 1/9/06



ANNOTATED SHEET

PDNO: 10007205-1 1 of 4

Inventor: Richard S. Seymour

Title: Methods and Systems For Managing Printer Components,
and Computer-Readable Media

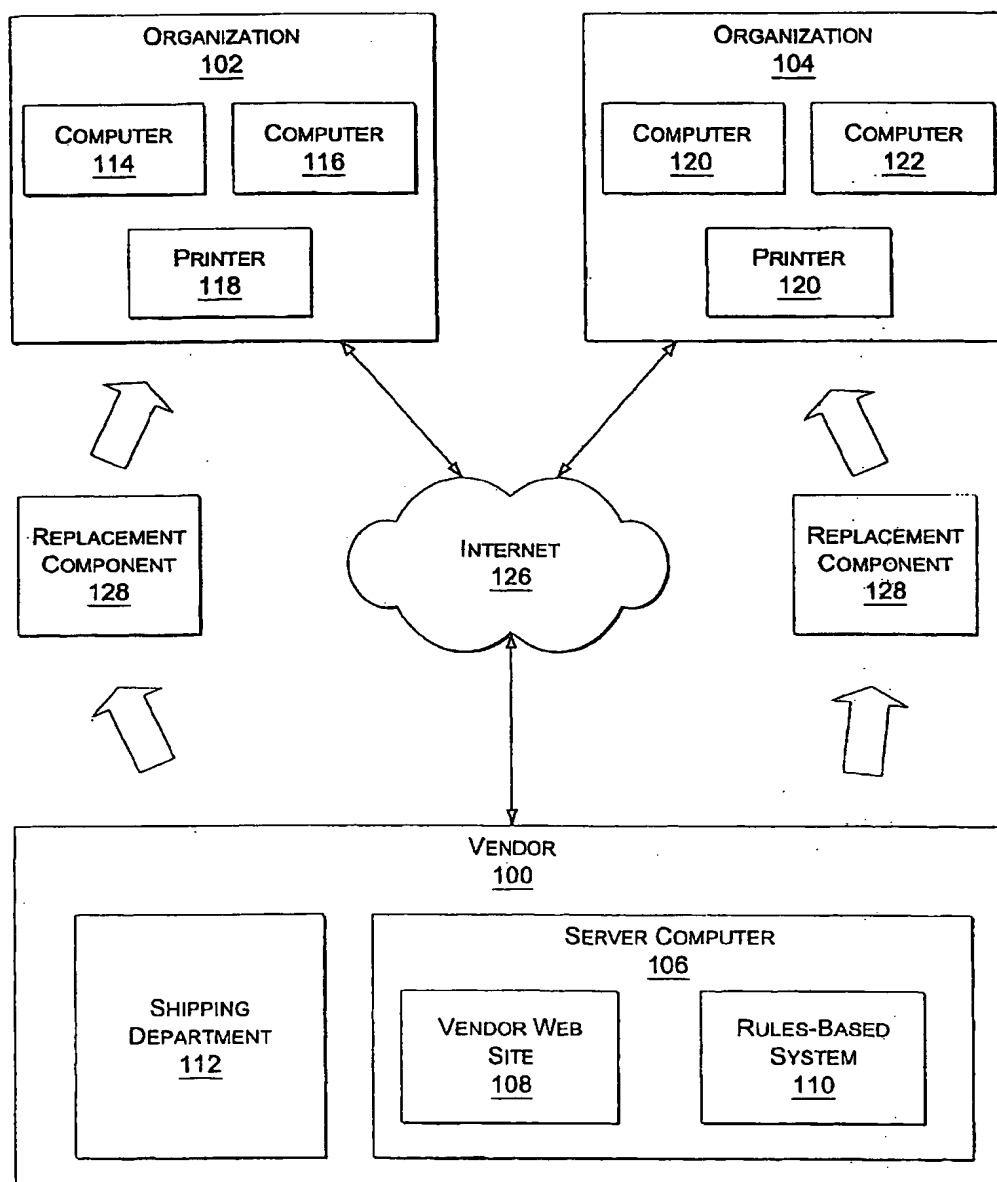


Fig. 1



ANNOTATED SHEET

PDNO: 10007205-1 2 of 4

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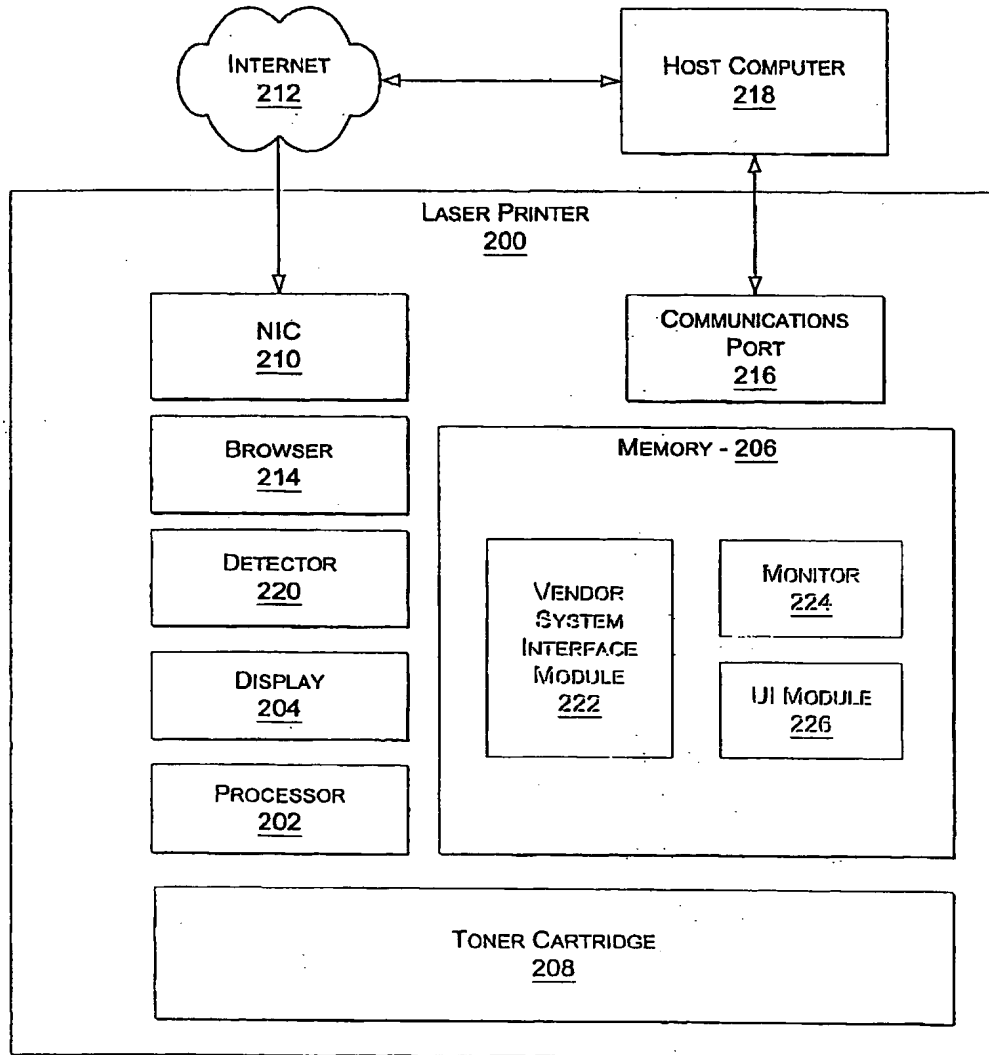


Fig. 2



ANNOTATED SHEET

PDNO: 10007205-1 3 of 4

Inventor: Richard S. Seymour

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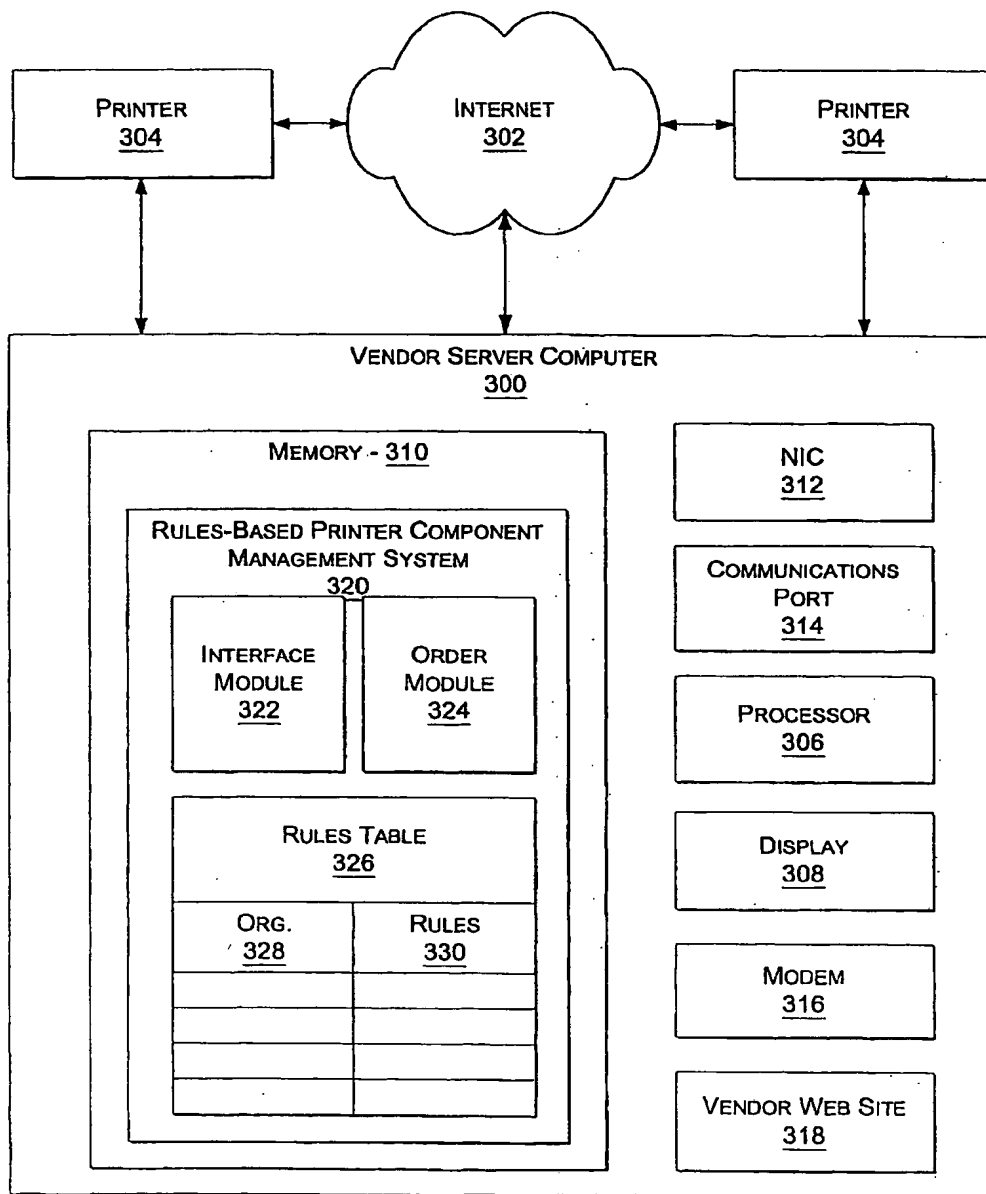


Fig. 3



ANNOTATED SHEET

PDNO: 10007205-1 4 of 4

Inventor: Richard S. Seymour

Title: Methods and Systems For Managing Printer Component
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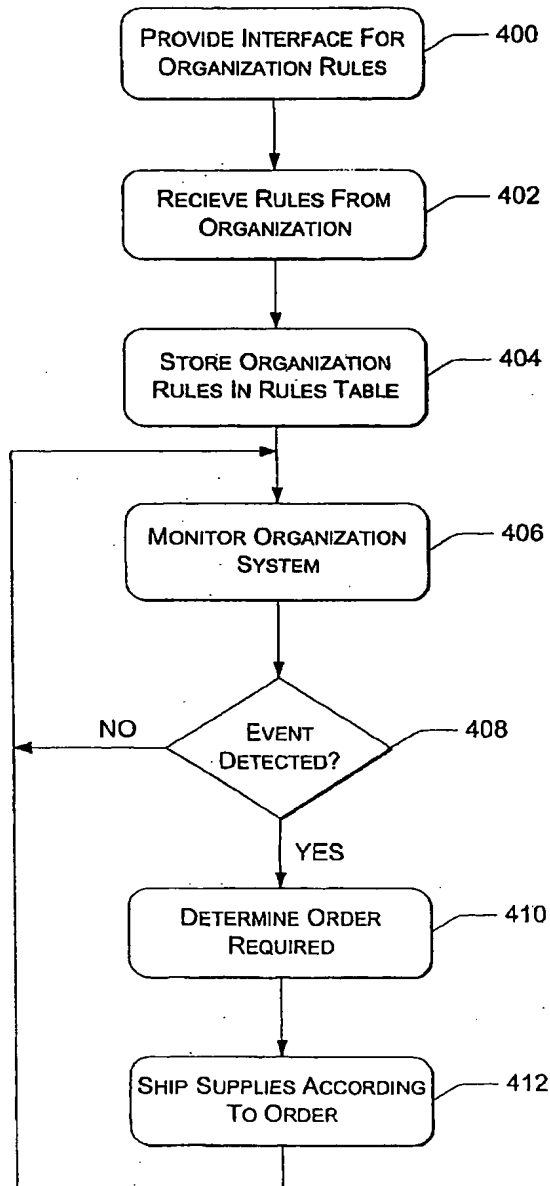


Fig. 4